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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/977,643

10/16/2001

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11/10/2005

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EXAMINER

TON, DANG T


ART UNIT

PAPER NUMBER

2666

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/977,643	Applicant(s) ROSENBERG, JONATHAN DAVID	
	Examiner DANG T. TON	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21 line 4, " the transport level connection voice information " has no antecedent basis.

1a. The disclosure is objected to because of the following informalities: Applicant should provide a status of a copending application 08/959,794 in the specification.

Appropriate correction is required.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982), *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. US 6,304,567. Although the conflicting claims are not identical, they are not patentably distinct from each other because of following correspondences

Regarding claim 7, a first plurality of telephone sets connected to first termination equipment which terminates said first plurality of telephone sets in first location corresponds to "a plurality of telephone sets connected to termination equipment which terminates said plurality of telephone sets" disclosed in claim 1, Lines 24-26 of U.S.

Patent No. US 6,304,567,

The Limitation a second plurality of telephone sets connected to second termination equipment which terminates said first plurality of telephone sets in first location corresponds to "a plurality of telephone sets connected to termination equipment which terminates said plurality of telephone sets" disclosed in claim 1, lines 24-26 of U.S. Patent No. US 6,304,567,

The Limitation, respective packet network telephone gateways connected to said first and second termination equipment and to a packet network corresponds to "respective telephone network gateways are connected to said termination equipment

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and to a packet network" disclosed in claim 1, Lines 27-28 of U.S. Patent No. US 6,304567,

The Limitation, packet gateways are arranged to multiplex voice telephone calls from said first plurality of telephone sets to said second plurality of telephone sets by establishing a transport level connection corresponds to "whereby said packet network gateways are connected to multiplex voice telephone calls among said plurality of telephone sets to a single transport level connection" disclosed in claim 1, Lines 29-33 of U.S. Patent No. US 6,304567,

The Limitation, transport level connection is maintained so long as voice calls are being made between the first and second locations with information from a number of voice telephone calls directed to different ones of second plurality of telephone sets multiplexed into a single packet is disclosed in "number of voice telephone calls are multiplexed into a single packet" disclosed in claim 1, Lines 30-34 of U.S. Patent No. US 6,304567,

The Limitation, packet network is the Internet corresponds to wherein said packet network is Internet disclosed in claim 1, Lines 32-34 of U.S. Patent No. US 6,304567,

The limitation, packet network telephone gateways operate to establish a packet network connection in response to a request from a user associated with one of said telephone sets and said gateways establish a channel for each user within each transport level connection corresponds to said packet network gateways operate to establish a packet network connection in response to a request from a user associated with one of said telephone sets and said gateways establish a channel for each user

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within each transport level connection disclosed in claim 1, Lines 35-39 of U.S. Patent No. US 6,304567,

The limitation, packet network telephone gateways operate to digitize voice signals from said telephone sets, to multiplex blocks of such digitized voice signals onto a transport level connection, and to packetize said multiplexed voice signal corresponds to said packet network telephone gateways operate to digitize voice signals from said telephone sets, to multiplex blocks of such digitized voice signals onto a transport level connection, and to packetize said multiplexed voice signal' disclosed in claim 1, Lines 39-43 of U.S. Patent No. US 6,304567,

The limitation, telephone gateways are connected to provide channel identification for each said channel corresponds to telephone gateways are connected to provide channel identification for each said channel disclosed in claim 1, Lines 44-45 of U.S. Patent No. US 6,304567.

Claim 7 differ from claim 1 of U.S. Patent No. US 6,304567 for following reasons.

Claim 7 do not claim telephone gateways are further connected to send sequence numbers in setup and teardown messages to allow for re-use of channel identification

Therefore claim 7 merely broaden the scope of claim 1 of U.S. Patent No. US 6,304567.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. See *In re Karlosn*, 136 USPQ 184 (CCPA). Also not *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). The omission of reference element whose function is not needed would

have been obvious to one skilled in art.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 21, and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baran et al. (US 4,771,425).

Regarding claims 1, 21, and 22, a first plurality of telephone sets connected to first termination

equipment (PBX-46), which terminates said first plurality of telephone sets in first location is anticipated by telephone sets (60, 62) connected to digital PBX (46)"disclosed in Fig-1 ;

The limitation, a second plurality of telephone sets connected to second termination equipment which, terminates said first plurality of telephone sets in second location PBX (54) is anticipated by "telephone sets (68, 70) connected to digital PBX

(54)" disclosed in Fig-1 .

The limitation, respective packet network telephone gateways connected to said first and second termination equipment and to a packet network is anticipated by

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packet network gateways (18, 16) connected to PBX 44, PBX 46 and to a packet network 12" as disclosed in Fig 1.

The Limitation, packet gateway are arranged to multiplex voice telephone calls from said first plurality of telephone sets to said second plurality of telephone sets by establishing a transport level connection is anticipated by "communication from telephone sets 60& 62 destined for phone sets 68 and 70 are multiplexed into same transpo4 stream carried on trunk 86 (transport level connection disclosed in Fig 1,element 84.

The Limitation, transport level connection is maintained so long as voice calls are being made between the first and second locations with information from a number of voice telephone calls directed to different ones of second plurality of telephone sets multiplexed into a single packet is anticipated by packet made up of 168 bits of voice or data information, which is about 21 voice channels/calls, where each voice channel carries 8 bits (hence it is clear that Baran's system could multiplex up to 21 voice calls into one packet for transmission over the packet network disclosed in column 6, line 59-column 7, line 3 and Fig. 3A

Regarding claim 4, a private branch comprises said termination equipment is anticipated by PBXM6 or PBX-54" disclosed in fig-1.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baran et al. (US 4,771,425) in view of Willaims et al. (US 5,883,891). Baran et al. teaches all the limitations of claim 3 (see the rejection for claim 1 above) except Baran et al. fails to disclose central office comprising a the termination equipment. Willaims et al. discloses termination of the telephone set being performed by the central office (refer fig 1A or column 4, Lines 50-55 of Willaims et al.). At the time the invention was made it would have been obvious to a person in ordinary skill in art to terminate the telephone sets of Baran et al. by central office instead of a PBX. One in ordinary skill in art would have been motivated to do so with the motivation being to utilize the high termination capacity of central office (since it is a known fact that central office can terminate more Lines than a PBX can).

6. Claims 2,5,6 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baran et al (US 4,771,425) in view of Gordon (US 5,608,786).

Regarding claim 2, Baran et al. teaches all the limitations of claim 3 (see the rejection for claim 1 above) except Baran et al. fails to disclose packet network is an Internet. Gordon teaches that Internet could be used as a packet network for long

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distance telephony (see Fig. 5 or column 8, lines 62-65). At the time the invention was made it would have been obvious to a person in ordinary skill in art use Internet in a packet network of Baran et al. One in ordinary skill in art would have been motivated to do so with a motivation being to provide long distance telephony communications at a low cost to save money (see column 9, Lines 1-4 of Gordon).

Regarding claim 5, Baran et al. also teaches packet network telephone gateways operate to establish a packet network connection in response to a request from a user associated with one of said telephone sets in Fig 1 and gateway establishing a channel for each user within each said transport level connection is disclosed by "establishment of 8 bit for each voice channel" in Fig 1 of Baran et al (US 4,771,425) also see column 6, Lines 59-66.

Regarding claim 6, Baran et al. teaches all the limitations of claim 3 (see the rejection for claim 5 above), Baran et al. also teaches "voice signals are digitized at the channel bank (46) and digitized voice signals are multiplexed and packetized at the gateway (Mux-18)" refer fig 1 of Baran et al. Baran et al. fails to teach voice signal are digitized at the gateway. Gordon teaches the gateway (access node 6) accepting and digitizing voice signals (see Fig 1 or column 6, Lines 55-59.) This mechanism eliminates channel bank. Thus it would have been obvious to one in ordinary skill in art at the time the invention was made to apply Gordon teaching to Baran et al. system with the motivation being to eliminate the need for separate channel bank to simplify the system and save money.

Regarding claim 19, Fig 1 of Baran et al. teaches a telecommunication system

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employing a packet network (12) in routing of telecommunication information from an originating point (56,58,60,62) to a destination point (68,70,72,74), comprising a plurality of communication switches (PBX 44, PBX 46, PBX 50) and plurality of gateways for (14,16,18) for interfacing respective ones of the communication switches (PBX 44, PBX 46, PBX 50) with the packet network (12) such that communication information received from different originating points (56,58,60,62) and exchanged between one of the gateways (14,16,18) is multiplexed at the same transport level connection is. disclosed in Fig 1 and in one data packet is disclosed in column 6, line 59-column 7, line 3 and Fig. 3A packet made up of 168 bits of voice or data information, which is about 21 voice channels/calls, where each voice channel carries 8 bits (hence it is clear that Baran's system could multiplex up to 21 voice calls into one packet for transmission over the packet network".

Baran et al. fails to disclose packet network is an internet. Gordon (US 5,608,786) teaches that Internet could be used as a packet network for long distance telephony (see Fig. 5 or column 8, Lines 62-65).

At the time the invention was made it would have been obvious to a person in ordinary skill in art use Internet in a packet network of Baran et al (US 4,771,425). One in ordinary skill in art would have been motivated to do so with a motivation being to provide long distant telephony communications at a low cost to save money (see column 9, lines 1-4 of Gordon (US 5,608,786)).

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baran et

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al. (US 4,771,425) and Gordon (US 5,608,786) as applied to claim 6 above, and further in view of Willaims et al. (US 5,883,891). Baran et al. and Gordon teach all the limitations of claim 7 (see the rejection for claim 6 above) except Baran et al. and Gordon fail to disclose that the telephone gateways are connected to provide channel identification for each channel. Willaims et al. discloses that nodes (gateways) along the route (channel) are designated by a unique IP address (channel identification) (refer column 1-line 60-column 2, line 5). At the time the invention was made it would have been obvious to a person in ordinary skill in art to modify the telephone sets of Baran et al. and Gordon by nodes (gateways) connected to provide channel identification for each channel. One in ordinary skill in art would have been motivated to do so to route the packet through Internet (see column 1 , Lines 60-67 Willaims et al.).

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al. (US 5,274,635) in view of Gordon (US 5,608,786). Fig. 1 of Rahman et al. teaches a telecommunication system employing a packet network in routing of telecommunication information from an originating point (40,42) to a destination point (28), comprising a plurality of communication switches (30) and plurality of gateways (22, 26) is multiplexed at the same transport level connection and in different data packets is disclosed in fig 3 of Rahman et al. "information from different originating points in different time slots 0, 1,2, is multiplexed in different packets 130, 131, 132 that is sent over the packet network.

Rahman et al. fails to disclose packet network is an Internet. Gordon teaches that

Internet could be used as a packet network for long distance telephony (see Fig. 5 or column 8, Lines 62-65 of Gordon).

At the time the invention was made it would have been obvious to a person in ordinary skill in art use Internet in a packet network of Rahman et al. One in ordinary skill in art would have been motivated to do so with a motivation being to provide long distant telephony communications at a low cost to save money (see column 9, Lines 1-4 of Gordon).

9. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

In the remarks of 8/25/2005, applicant indicated that the terminal disclaimer being concurrently filed herewith to obviate the rejection. However, there is no indication that terminal disclaimer has been filed in the record. applicant also traverses the rejections under 35 U.S.C under 102 and 103. The traversal is based on ground that the reference does not teach voice telephone calls being multiplexed into a single packet as claimed. This argument is not found to be persuasive. Applicant's attention is directed at column 6 line 59 to column 7 line 3 wherein it teaches the number of telephone calls are multiplexed into a single packet.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

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MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T. TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton



DANG TON
PRIMARY EXAMINER